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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,136	06/06/2001	Selman Abdul-Halim Ali	5673-59226	1131

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EXAMINER

WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 09/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,136

Applicant(s)

ALI ET AL.

Examiner

Michael Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action*.

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-6 and 8, drawn to a method of exposing target cells to a cell damaging agent and antigen presenting cells, wherein the cell-damaging agent and the antigen presenting cells are delivered *in vivo*.

Group II, claims 1-5, 7 and 8, drawn to a method of exposing target cells to a cell damaging agent and antigen presenting cells, wherein the cell-damaging agent and the antigen presenting cells are delivered to the target cells *in vitro* and the treated target cells are implanted into a subject.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the target cells or the antigen presenting cells can be delivered to the patient, each of which is a different special technical feature.

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2. This application contains claims encompassing more than one species of the generic “cell-damaging agent”. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Claim 1-3 and 6-8 are generic to any cell-damaging agent. Claim 4 is generic to a cell damaging agent that is any viral vector. Claim 5 is generic to a cell-damaging agent that is any virus vector comprising an immunomodulatory protein and/or a tumor antigen.

The species are disclosed throughout the specification on pg 5, lines 4-14, and pg 7, line 5, through pg 8, line 17. Examples of “species” are GM-CSF, RANTES, and OX40 (pg 8, line 8). Examples of generic “cell-damaging agents” are antitumor pharmaceutical (pg 5, line 7), a micro-organism comprising a nucleic acid sequence encoding “one or more immunomodulatory proteins and/or one or more tumour antigens” is generic.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. To clarify what the examiner considers a single species, electing a “herpes virus” or “a virus comprising a nucleic acid sequence encoding one or more immunomodulatory proteins and/or one or more tumour antigens” will be considered non-responsive because they are generic to a number of distinct species having different structures and functions. Electing a herpes virus encoding GM-CSF (pg 13, line 6) would be considered responsive. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is

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allowable or that all claims are generic is considered non-responsive unless accompanied by an election. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Radiation, viruses, bacteria, proteins, and other disclosed "cell-damaging agents" have different structures, different functions, different modes of operation and are not disclosed as being used together. Different viruses have different target tissues and different structures. Viruses encoding different proteins have different purposes and different structures. The burden required to search and consider all "cell-damaging agents" or even the narrowest embodiment, "viruses encoding immunomodulatory proteins and/or tumor antigens," in the claimed invention would be undue.

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-0120.

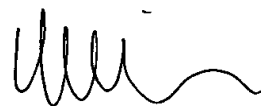
Questions of formal matters can be directed to the patent analyst, Dianiece Jacobs, who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-3388.

Questions of a general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

If attempts to reach the examiner, patent analyst or Group receptionist are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

The official fax number for this Group is (703) 308-4242.

Michael C. Wilson



MICHAEL C. WILSON
PATENT EXAMINER